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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/645,590	08/22/2003	Jeff Pace	2003P12857US	8583

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SEIMENS CORPORATION
INTELLECTUAL PROPERTY
170 WOOD AVENUE SOUTH
ISELIN, NJ 08830

EXAMINER

KIM, CHRISTOPHER S

ART UNIT	PAPER NUMBER
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3752

MAIL DATE	DELIVERY MODE
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02/16/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.		Applicant(s)	
	10/645,590		PACE ET AL.	
	Examiner		Art Unit	
	Christopher S. Kim		3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-19, 22 and 24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-19, 22 and 24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. The response filed October 27, 2009 is acknowledged.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "angle of inclination for at least on of the plurality of passages is different than the other passages" recited in claim 24 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering

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of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The disclosure is objected to because of the following informalities: the priority claim to application no. 09/605,654 should indicate "now U.S. Patent No. 6,799,733" or equivalence thereof.

Appropriate correction is required.

Claim Objections

5. Claim 22 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 19. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 112

6. Claims 14-19, 22, 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter

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which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 19 and 22 recite the limitation "the passages having ends that intersect to form a common seat exit passage at the fuel outlet." The disclosure, as originally filed, fails to disclose that the passages have ends that intersect. The specification discloses, on page 5, lines 28-29, "The modified seat 140 has a two inclined passages 141 and 142 which terminate into the exit passage 143."

7. Claims 14-19, 22 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 recites the limitation "at least some of the passages" in line 13. It is uncertain how many passages are limited by the recitation.

Claim 22 recites the limitation "at least some of the passages" in line 12. It is uncertain how many passages are limited by the recitation.

Claim Rejections - 35 USC § 102

8. Claims 14-19, 22, 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoppel (4,532,906).

Hoppel discloses a method comprising:

engaging a tip of a needle 15 against a surface 16 of a seat 17, 23 to form a seal;

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providing the seat 17, 23 with a plurality of straight passages 28 between the surface 16 and a fuel outlet 31;

the passages 28 having ends that intersect to form a common seat exit passage 29 at the fuel outlet;

each of the plurality of passages 28 having a central axis having an angle of inclination relative to the longitudinal axis ;

the angle of inclination being the same for at least some of the passages 28 (see figure 2);

supplying fuel.

Regarding claim 24, Hoppel discloses, in figure 6, different angle of inclination.

9. Claims 14-19, 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Katsuno et al. (5,035,358).

Katsuno discloses a method comprising:

engaging a tip of a needle 29 against a surface of a seat 21, 22 to form a seal;

providing the seat 21, 22 with a plurality of straight passages 31b between the surface and a fuel outlet;

the passages 31b having ends that intersect to form a common seat exit passage 30 at the fuel outlet;

each of the plurality of passages 31b having a central axis having an angle of inclination relative to the longitudinal axis ;

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the angle of inclination being the same for at least some of the passages 31b (see figure 2);
supplying fuel.

Double Patenting

10. The terminal disclaimer filed July 17, 2006 fails to comply with 37 CFR 1.321 because it is not signed by an attorney of record.

11. Claims 14-19, 22, 24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 13-19 and 22-24 of U.S. Patent No. 6,799,733. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of '733 fully discloses the claimed invention of the present application. The '733 claims recite further details than the presently claimed invention, i.e. the currently claimed invention is broader than the '733 claims. The absence of the detailed features are a mere elimination of parts/features and its function. It has been held that omission of an element and its function in a combination where the remaining elements perform the same functions as before involve only routine skill in the art. *In re Karlson*, 136 USPQ 184.

Response to Arguments

12. Applicant's arguments filed May 26, 2009 have been fully considered but they are not persuasive.

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13. Applicant argues that the double patenting rejection is improper because U.S. Patent No. 6,799,733 fails to disclose "straight passages...that intersect to form a common seat exit passage." U.S. Patent No. 6,799,733 discloses, in claim 1, "a portion of the passage surface aligned on the same line with and contiguous to the surface of the seat on a common plane such that each central axis intersects the longitudinal central axis and each other at a common point on the longitudinal central axis."
14. Remainder of applicant's arguments with respect to claims 19 and 22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher S. Kim whose telephone number is (571) 272-4905. The examiner can normally be reached on Monday - Friday, 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on (571) 272-1184. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Christopher S. Kim/
Primary Examiner, Art Unit 3752

CK